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Dr. Jim Considine  
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In re Application of	:	
MYERS, et al.	:	DECISION ON PETITION
Application No.: 08/809,677	:	
PCT No.: PCT/US94/10935	:	
Int. Filing Date: 27 September 1994	:	UNDER 37 CFR 1.137(b)
Priority Date: 27 September 1994	:	
Attorney Docket No.: 07354/004001	:	
For: ARTIFICIAL LIVER APPARATUS AND	:	
METHOD	:	

This is a decision on applicant's "PETITION FOR UNDER 37 CFR 1.137(b) FOR REVIVAL OF AN APPLICATION FOR ABANDONED UNINTENTIONALLY" filed in the United States Patent and Trademark Office (USPTO) on 01 September 2000. The required small entity petition fee of \$605.00 (37 CFR 1.17(m)) has been included.

### **BACKGROUND**

On 27 September 1994, applicant filed international application PCT/US94/10935. A Demand for international preliminary examination, in which the United States was elected, was filed on 25 April 1996, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 March 1997.

On 27 March 1997, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a copy of the International Application as required by 35 U.S.C. 371(c)(2). An oath or declaration as required by 35 U.S.C. 371(c)(4) was not filed.

On 14 August 1997, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO 905) informing applicant of the need to provide an oath or declaration of the inventor(s) for assistance in complying with 37 CFR 1.107.

Applicant's failure to respond to the notification within the time period specified in 37 CFR 1.107(a) resulted in the application being deemed abandoned.

On 21 July 1998, applicant was mailed a "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO 900) for failing to respond to the 14 August 1997 "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371".

MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) within the time period set therein.

On 19 October 1998, applicant filed a "PETITION UNDER 37 CFR 1.137(a) TO REVIVE UNAVOIDABLY ABANDONED APPLICATION."

On 08 March 1999, counsel from the law firm of Fish and Richardson filed a Request to Withdraw as attorneys.

On 14 May 1999, applicant was mailed a decision granting applicant's 19 October 1999 petition to revive and withdrawal of attorney. Applicant was informed that the application was being forwarded to the National Stage Processing Branch of the International Division for a re-mailing of the Notification of Missing Requirements to the new correspondence address indicated in the 08 March 1999 Request to Withdraw as attorneys.

On 30 June 1999, was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date and providing a surcharge of \$130.00 for providing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e).

On 12 July 1999, applicant responded by filing a copy of the power of attorney as filed on 16 March 1998, a copy of revocation of previous powers of attorney and grant of new power of attorney as submitted on 06 July 1999, a check in the amount of \$240.00 and a petition for a one-month extension of time.

On 24 September 1999, a "NOTIFICATION OF A DEFECTIVE RESPONSE" (Form PCT/DO/EO 916) indicating that an oath or declaration of inventor(s) in compliance with 37 CFR 1.497(a) and (b) was still needed. This communication was mailed to applicants former attorney notwithstanding the change of correspondence address indicated in the 14 May 1999 decision.

On 27 March 2000, applicant filed a status letter inquiring into the present status of the subject application.

On 12 June 2000, was mailed a "NOTIFICATION OF ABANDONMENT" (Form

## DISCUSSION

### **I. Petition under 37 CFR 1.137(b)**

Applicant's petition is **DISMISSED as moot**. The above-captioned application is not abandoned as the "NOTIFICATION OF A DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) was mailed to the wrong address.

### **II. Revocation of Previous Power of Attorney and Appointment of New Attorney**

The present decision and future communications will be mailed to Dr. Considine as per the previous decision mailed 14 May 1999. The "Revocation of Previous Power of Attorney and Grant of New Power of Attorney" filed 12 July 1999 pursuant to 37 CFR 3.71 is ineffective because the purported assignment has not furnished sufficient proof that "Xenogenics Industries" owns the entire interest. The recorded assignment refers to "Exten Industries" and has only been signed by one of the three named inventors.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED as moot**.

The "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) mailed 12 June 2000 is hereby **VACATED**.

The petition fee of \$605.00 will be credited to Deposit Account No.: 02-4070.

This application is being returned to the United States Designated/Elected Office (DO/EO US) for continued processing in accordance with this decision, namely remailing of the "NOTIFICATION OF A DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) originally mailed on 24 September 1999 to the correct correspondence address of **Dr. Jim Considine, Exten Industries, 9625 Black Mountain Road, Suite 218 San Diego, CA 92126-4564** as indicated in the 14 May 1999 decision.



D. J. A. Putonen



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